

REMARKS

The above amendments and these remarks are responsive to the non-final Office action dated August 20, 2008, and are being filed under 37 C.F.R. § 1.111. Claims 41, 44, 46–52, 54–60, 62–64, 96, and 99–156 are pending in the application, with claims 47, 54, 104, 110, 122, 128, 141, and 147 withdrawn from consideration. In the Office action, the Examiner

- Rejected claims 96, 99–102, 105, 107, 111, 115–120, 123, 125, 129, 132, 134–139, 142, 144, 148, 151, and 153–156 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,179,839 to Weiss et al. (“Weiss”);
- Rejected claims 103, 108, 109, 114, 121, 126, 127, 131, 133, 140, 145, 146, 150, and 152 under 35 U.S.C. § 103(a) as being unpatentable over Weiss;
- Rejected claims 105, 106, 124, and 143 under 35 U.S.C. § 103(a) as being unpatentable over Weiss in view of U.S. Patent No. 6,623,486 to Weaver et al. (“Weaver”);
- Rejected claims 112, 130, and 149 under 35 U.S.C. § 103(a) as being unpatentable over Weiss in view of U.S. Patent No. 6,793,658 to LeHuec et al. (“LeHuec”); and
- Allowed claims 41, 44, 46, 48–52, 55–60, and 62–64.

Applicants traverse the rejections, contending that all of the claims are patentable over the cited references, taken alone or in combination. Nevertheless, to expedite the issuance of a patent and to more particularly claim aspects of the invention that applicants would like to patent now, applicants have amended each of the rejected independent claims, namely, claims 96, 99, and 100. Furthermore, applicants have presented remarks showing that all of the claims are patentable over the cited references. Accordingly, applicants respectfully request reconsideration of the

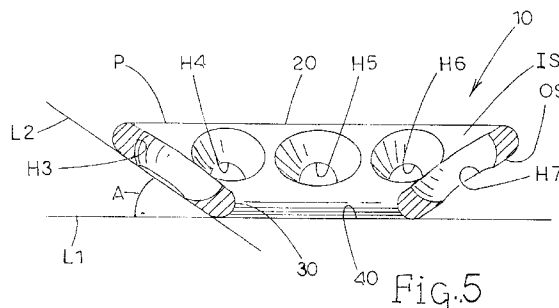
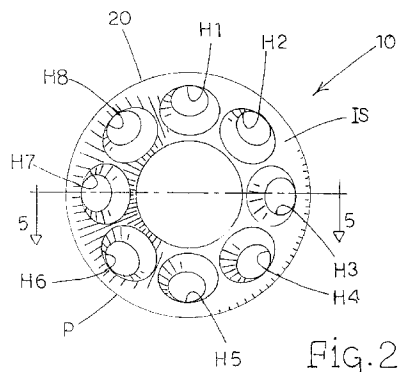
application and prompt issuance of a Notice of Allowance covering all of the pending claims.

I. Claim Rejections – 35 U.S.C. §§ 102 and 103

The Examiner rejected each of claims 96, 99–103, 105–109, 111–121, 123–127, 129–140, 142–146, and 148–156 as being anticipated by Weiss or as being obvious over Weiss alone or in combination with Weaver or LeHuec. Applicants traverse the rejections, contending that all of the claims are patentable over the cited references. Nevertheless, for the reasons set forth above, applicants have amended independent claims 96, 99, and 100. Each of the rejected claims is patentable for at least the reasons set forth below.

Each of the rejected independent claims (claims 96, 99, and 100) was rejected as being anticipated by Weiss. However, each of these independent claims has been amended to recite, in part, “selecting a bone plate including a body portion with a bone-facing surface and further including a post **connected to the body portion and** extending from the bone-facing surface of the body portion” and “**wherein placing the bone plate into a cavity is performed while the post remains connected to the body portion.**” The cited references, taken alone or in combination, do not disclose or suggest the steps of selecting and placing recited in currently amended claims 96, 99, and 100.

Weiss relates to a bone fusion apparatus and method. Figures 2 and 5 of the reference, which are reproduced below to facilitate review, present respective top plan and cross-sectional views of a preferred embodiment (10) of the bone fusion apparatus.



Fusion apparatus 10 comprises “an annular, cone-shaped plate P” (col. 4, lines 35 and 36). Plate P defines eight holes (H1-H8) for receiving fasteners, such as bone screws.

In the Office action, the Examiner stated that one of the fasteners of Weiss is considered a post. However, Weiss discloses placement of the fasteners through holes H1-H8 only after plate P is disposed on bone. Furthermore, Weiss does not disclose or suggest any connection of the fasteners to plate P independent of bone. Therefore, Weiss does not disclose or suggest placing a bone plate into a cavity, where “placing the bone plate into a cavity is performed while the post remains connected to the body portion,” as recited in currently amended claims 96, 99, and 100. Weaver and LeHuec, taken alone or combination, do not correct both of these deficiencies in Weiss.

It also would not have been obvious to pre-connect a fastener to plate P, in one of holes H1-H8, before placing plate P on bone, because there is substantial motivation not to pre-connect any of the fasteners. First, a pre-connected fastener would complicate or preclude threaded engagement of the fastener with bone if the fastener is a bone screw (as suggested by Weiss). Second, a pre-connected fastener would increase the complexity of plate installation by requiring a receiving hole for the pre-connected fastener

to be drilled accurately before plate P is installed on bone. Third, the pre-connected fastener would restrict repositioning of plate P on bone, thereby restricting the ability to seat plate P properly before installation of the other fasteners. Therefore, it would not have been obvious to modify Weiss to achieve the invention of any of claims 96, 99, and 100.

In summary, claims 96, 99, and 100 are neither anticipated by, nor obvious over, the cited references and should be allowed. Claims 101–103, 105–109, 111–121, 123–127, 129–140, 142–146, and 148–156, which each depend from claim 96, 99, or 100, also should be allowed for at least the same reasons as claims 96, 99, and 100.

II. Rejoinder of the Withdrawn Claims

Claims 47, 54, 104, 110, 122, 128, 141, and 147 have been withdrawn from consideration. However, applicants respectfully request rejoinder and allowance of each of the withdrawn claims. Rejoinder is proper according to MPEP § 821.04 because each withdrawn claim requires all the limitations of an allowable independent claim (i.e., claim 41, 96, 99, or 100).

III. Conclusion

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowance covering all of the pending claims. If there are any questions regarding this communication, or if a telephone interview would in any way advance prosecution of the application, the Examiner is encouraged to

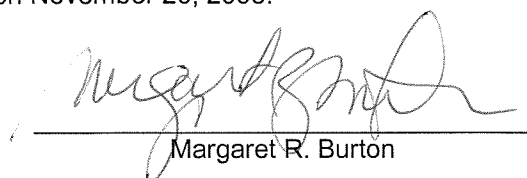
contact the undersigned attorney of record, James R. Abney, or his associate, Stanley M. Hollenberg (Reg. No. 47,658), both at the telephone number listed below.

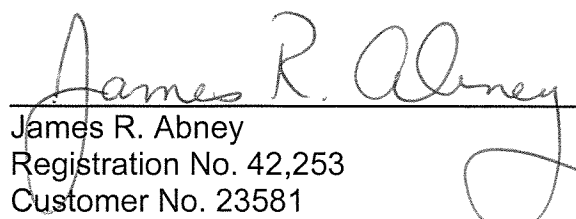
Respectfully submitted,

KOLISCH HARTWELL, P.C.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being submitted via the EFS-Web Electronic Filing System to the U.S. Patent and Trademark Office on November 20, 2008.


Margaret R. Burton


James R. Abney
Registration No. 42,253
Customer No. 23581
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Assignee